

**REMARKS**

Claims 5, 11, 14, and 35-37, and 41-46 are now pending in this application. Claims 4-6, 8, 9, 12, 19, 20, 23, 33-36, 39, and 40 have been rejected. Claims 11 and 14 have been objected to. Claims 4, 6, 8, 9, 12, 19, 20, 23, 33, 34, and 38-40 are cancelled herein. Claims 1-3, 7, 10, 13, 15-18, 21, 22, and 24-32 are previously cancelled. New claims 41-46 are added. Claims 5, 35, 36, and 37 are amended herein to change their dependencies. Claims 11 and 14 are amended to clarify the invention.

Claim 40 has been objected to. Claim 40 has been cancelled, making its objection moot.

Claims 11 and 14 have been deemed allowable but have been objected as being dependent upon a rejected base claim. Claims 41 and 42 include the subject matter of allowable claims 11 and 14, respectively, and Applicants respectfully request that they be deemed allowable.

Claims 4-6, 8, 19, 20, 23, 33, 35, and 39 have been rejected under 35 U.S.C. § 103(a) as obvious over Cancer Gene Therapy, 2001, 8:649-654 (Ito et al.). Claims 4, 6, 8, 19, 20, 23, 33, and 39 have been cancelled, making their rejection moot.

Claim 5 depends from claim 41 and claim 41, as explained above, contains allowable subject matter. Accordingly, claim 5 is patentable over Ito et al. and notice to that effect is respectfully requested.

Claim 35 now depends from claim 11 and recites that the magnetic fine particles comprise ferrite. Although the Office Action rejects claim 35, the Office Action fails to explain how Ito et al. discloses or suggests ferrite. Accordingly, it is Applicants' position that claim 35 is patentable over Ito et al. and notice to that effect is respectfully requested.

Claim 34 has been rejected under 35 U.S.C. § 103(a) as obvious over Ito et al. in view of Biotechnol Appl Biochem, 1994, 21:125-137 (Shinkai et al. I) and Jpn J. Hyperthermic Oncol, 1994, 10:177, abstract (Shinkai et al. II).

Claim 34 has been cancelled, making its rejection moot.

Claim 34 has been rejected under 35 U.S.C. § 112, first paragraph. Claim 34 has been cancelled, making its rejection moot.

Claims 4-6, 8, 9, 12, 19, 20, 23, 33, 34, 35, 36, 29, and 40 have been rejected under 35 U.S.C. § 112, first paragraph, as being nonenabled. The Office Action states that there is enablement for a method for treating a malignant tumor comprising: administering (a) either interleukin-2 (IL-2), granulocyte colony stimulating factor (GMCSF), or tumor necrosis factor- $\alpha$  (TNF- $\alpha$ ) to a malignant tumor, (b) administering magnetic fine particles to said tumor and (c) heating said magnetic fine particles. The claims, as currently drafted, are believed to be enabled. Applicants are not discussing the merits of the Office Action's enablement rejection since the present claims are believed to be enabled when analyzed in light of what the Office Action deemed as being

enabled. Accordingly, Applicants respectfully request that the enablement rejection be withdrawn.

Claims 11 and 14 have been amended and recite the magnetic fine particles comprising magnetite or ferrite or permalloy. The Office Action deemed claims 11 and 14 allowable when they recited only magnetite. Claims 11 and 14, in also including ferrite and permalloy as possibilities, are still patentable over the cited art since the Office Action has not demonstrated the disclosure or suggestion of ferrite or permalloy in the cited art. Claims 35 and 36 (which depend from claim 11) and claims 44 and 45 (which depend from claim 14) are patentable at least for the reason that they depend from a patentable base claim. Claims 37, 43, and 46 depend from claim 41 or claim 42 and are patentable at least for the reason that they depend from a patentable base claim.

The Office Action deems claim 37 as drawn to a nonelected invention. However, claim 37 currently depends from claim 41, which contains allowable subject matter. Furthermore, claim 37 is a method claim, just like claim 41. Claim 37 is merely adding an additional limitation to claim 41 and should be examined along with claim 41 since no additional work would be required on the part of the Examiner. To the extent that the Examiner believes that the subject matter of claim 37 is directed to a nonelected invention, such restriction requirement is traversed. The Office Action states that methods and

hyperthermia agents comprising an antibody were originally part of Groups I and II of the Restriction mailed 7/27/05. The Office Action also states that Applicants confirmed the election of Group III in the Amendment filed April 6, 2006 and that Group III is not drawn to magnetite fine particles comprising an antibody. Applicants respectfully point out that Groups I and II of the Restriction mailed 7/27/05 were not directed to any method that included the use of antibodies. Claim 3, as filed, included the recitation of antibodies but claim 3 as filed was not a method claim. Applicants' confirmation of the election of Group III does not mean that a method directed to the use of antibodies was automatically excluded from Group III since none of the claims had previously recited a method that included the use of antibodies. In claim 37, Applicants are merely adding a further limitation to a method that is currently under examination and stating that claim 37 is constructively nonelected is inappropriate. The reasoning for the examination of claim 37 also applies to claim 46.

Support for the claim amendments and for the new claims is present since Applicants have merely rearranged claim elements that were already recited in the claims.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg  
C. Bruce Hamburg  
Reg. No. 22,389  
Attorney for Applicants

*BD* and,

By Ricardo Unikel  
Ricardo Unikel  
Reg. No. 52,309  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340